



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/645,724

08/20/2003

Paul Edwin Jones

2705-283

1756

20575

7590

12/11/2008

MARGER JOHNSON & MCCOLLOM, P.C.
210 SW MORRISON STREET, SUITE 400
PORTLAND, OR 97204

EXAMINER

JUNTIMA, NITTAYA

ART UNIT

PAPER NUMBER

2416

MAIL DATE

DELIVERY MODE

12/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/645,724 | Applicant(s) JONES ET AL. | |
| | Examiner NITTAYA JUNTIMA | Art Unit 2416 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-36 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 9/12/2008.
2. **Claims 1-11, 13-36, and 38-42** are pending (claims 12 and 37 were canceled).

Drawings

3. The drawings are objected to because in Fig. 5:
 - the arrow that corresponds to “RELEASE COMPLETE (busy)” should be pointing from User B’s Endpoint to Gatekeeper/Proxy (see specification, page 10, lines 11-12);
 - the arrow that corresponds to the second “SETUP (delay ringing until explicit notification)” should be pointing from Gatekeeper/Proxy to User B’s Endpoint (see specification, page 10, lines 12-13).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

Art Unit: 2416

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. **Claims 26 and 31** are objected to because of the following informalities:
- in claims 26 and 31, line 2, “the computer” should be changed to “a computer.”
- Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 13-36, and 38-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claim 1**, the claim as amended includes a delay point that indicates *both* call completion on busy *and* call completion on no answer. However, it is unclear what a delay point actually is – whether it is call completion on busy *or* call completion on no answer as in an actual call, only one condition of call completion on busy OR call completion on no answer can happen. That is within the same call, the connection to the called party is either busy or no answer.

Art Unit: 2416

In independent **claims 5, 15, 21, 26, 31, 35, 36, and 42**, the claims as amended similarly recite that the delay point indicating feature discovery of the called endpoint and call supplementary services. However, referring to Fig. 4 which discloses a call flow diagram for delayed call establishment for maintenance purposes and that the delay point is when bidirectional media is established (see specification, page 9, lines 18-20) which presumably corresponds to the claimed "feature discovery of the called endpoint," but on the other hand, Fig. 5 discloses a call flow diagram for delayed call establishment in a call back busy signal situation and that the delay point is identified as explicit notification (see specification, page 10, lines 9-11). In addition, the specification discloses that a delay call establishment with delay point that indicates feature discovery of the called endpoint is initiated by the calling endpoint (page 4, lines 21-23), while a delay call establishment with delay point that indicates supplementary services is initiated by an intermediary, not a calling endpoint (page 5, lines 4-7 and 15-19).

Therefore, the claims are vague and indefinite as it cannot be determined what exactly the delay point or delay condition indicates since (a) Fig. 4 and Fig. 5 are disclosed as two mutually exclusive embodiments, and (b) the delay point indicating feature discovery as initiated by the calling endpoint using a call request/setup and the delay point indicating supplementary services as initiated by the intermediary using a call request/setup are two mutually exclusive embodiments.

In **claim 38**, claim 1 as amended recites that the delay point indicating call supplementary services including call completion on busy and call completion on no answer which corresponds to Fig. 5. However, claim 38 recites that the delay point indicates diagnostic testing without

Art Unit: 2416

alerting a user of the called endpoint which corresponds to Fig. 4. In addition, Fig. 4 discloses that the delay point indicates "bidirectional media is established," *not* "diagnostic testing without alerting a user of the called endpoint" as claimed (see specification, page 9, line 18-20). Rather, it is the call purpose of Fig. 4 that is to perform maintenance testing without alerting the user (specification, page 5, lines 20-25 and page 10, lines 1-6).

Therefore, it cannot be determined what exactly the delay point indicates since Figs. 4 and 5 are disclosed as two mutually exclusive embodiments, and Fig. 4 discloses the delay point that indicates "bidirectional media is established," *not* "diagnostic testing without alerting a user of the called endpoint" as claimed.

In **claim 40**, similar to claim 38 above and based on claim 21 from which it depends, it cannot be determined what exactly the delay point indicates since (a) Figs. 4 and 5 are disclosed as two mutually exclusive embodiments, (b) the delay point indicating feature discovery as initiated by the calling endpoint and the delay point indicating supplementary services as initiated by the intermediary are two mutually exclusive embodiments, and (c) Fig. 4 discloses the delay point that indicates "bidirectional media is established," *not* "diagnostic testing without alerting a user of the called endpoint" as claimed.

In **claim 42**, the claim includes a delay point that indicates *both* call completion on busy *and* call completion on no answer. However, it is unclear what a delay point actually is – whether it is call completion on busy *or* call completion on no answer as in an actual call, only

Art Unit: 2416

one condition of call completion on busy OR call completion on no answer can happens. That is within the same call, the connection to the called party is either busy or no answer.

Allowable Subject Matter

6. **Claims 1, 5, 15, 21, 26, 31, 35, and 36** would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Please note that if the applicant changes the claims to be the same as before the Amendment, the previous Final rejection will apply.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NITTAYA JUNTIMA whose telephone number is (571)272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571.272.6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

Art Unit: 2416

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nittaya Juntima/
Primary Examiner, Art Unit 2416
12/8/2008